Attorney Docket # 502901-327PUS - 302451.000 Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
Gunter WAGNER et al.
Serial No.: 10/585,905
Filed: July 12, 2006
For: Fuel Feed Unit

Examiner: Comley, Alexander B.
Group Art: 3746

Mail Stop **Appeal Brief - Patents**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

SIR:

This is an appeal, pursuant to 37 C.F.R. § 41.37 from the decision of the Examiner in the above-identified application, as set forth in the Final Office Action wherein the Examiner finally rejected Appellants' claims. The rejected claims are reproduced in the Appendix A attached hereto. A Notice of Appeal was filed on June 2, 2011 with a Pre-Appeal Brief Request for Review. A Notice of Panel Decision issued on August 2, 2011. Thus, the period for response ends on September 2, 2011. Appellants request a one-month Extension of Time of the original shortened statutory response period to file this Appeal Brief. Please charge the amount of **$130** in payment of a Petition for the one-month extension along with the fee of **$540** to our Patent and Trademark Office Deposit Account No. 503111.

Any additional fees or charges in connection with this application may be charged to our Patent and Trademark Office Deposit Account No. 503111.

I. REAL PARTY IN INTEREST

The assignee, Siemens Aktiengesellschaft, of applicants, Gunter WAGNER and Juergen ZOELL, is the real party of interest in the above-identified U.S. Patent Application.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals and/or interferences related to the above-identified application at the present time.

III. STATUS OF CLAIMS

Claims 1-11 have been rejected. Claims 1-11 are on appeal.

IV. STATUS OF AMENDMENTS

There have been no Amendments filed subsequent to the Final Office Action.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

Appellants' disclosed invention of independent **Claim 1** is directed to a fuel feed unit for delivering fuel (see pg. 3, lines 2-232 of the Substitute Specification filed July 12, 2006; Fig. 2). The fuel feed unit comprises an electric motor (1) (see pg. 3, lines 22-23 of the Substitute Specification filed July 12, 2006; Fig. 1); an electric motor stator ring (8) (see pg. 4, lines 1-2 of the Substitute Specification filed July 12, 2006; Fig. 2); magnet shells (10) arranged inside the stator ring (8) (see pg. 3, lines 25-26 of the Substitute Specification filed July 12, 2006; Figs. 1 and 2); and a motor casing (9) to accommodate the stator ring (8) (see pg. 3, lines 24-25 of the Substitute Specification filed July 12, 2006; Figs. 1 and 2), where the electric motor stator ring (8)

and the magnet shells (10) comprise a single-piece body formed as a single piece of a single material (see pg. 1, lines 28-29 of the Substitute Specification filed July 12, 2006; Fig. 2).

VI. GROUNDS OF REJECTION TO BE REVIEWED IN APPEAL

1. Whether claims 1-11 are patentable under 35 U.S.C. §103(a) over U.S. Patent No. 5,106,277 ("*Tuckey*") in view of U.S. Patent No. 5,121,021 ("*Ward*")?

VII. ARGUMENT

1. REJECTION OF CLAIM 1 AND DEPENDENT CLAIMS 2-11 OVER *TUCKEY* IN VIEW OF *WARD*

Independent claim 1 recites "wherein the electric motor stator ring and the magnet shells comprise a single-piece body formed entirely from a same material". As explained in detail below, the combination of *Tuckey* and *Ward* fails to teach or suggest that the electric motor stator ring and the magnet shells comprise a single-piece body formed entirely of the same material.

The Examiner (at pg. 3 of the Final Office Action) acknowledges that *Tuckey* fails to teach or suggest the specific detail of a one-piece body comprising the stator ring (30) and the magnet shells (32), and cites *Ward* to cure this deficiency of *Tuckey*.

Appellants, however, contend that no proper combination of *Tuckey* and *Ward* achieves the subject matter of independent claim 1. The Examiner takes the position that *Ward* "discloses a one-piece, combined frame-and-stator assembly 12 for a dynamoelectric machine". Accordingly, the Examiner asserts that "it would have been obvious to one having ordinary level of skill in the art at the time the invention was made to ... integrate the magnets with the stator (like Ward's integration of the stator with the casing), since it has been held that forming in one

piece an article which has formerly been formed in two pieces involves only routine skill in the art. *Howard v Detroit Stove Work, 150 U.S. 164*". Appellants disagree.

Howard v. Detroit Stove Works does not apply here, because *Howard v. Detroit Stove Works* has all to do with riveting together multiple pieces of a stove that are formed from the same material. The riveting together of multiple pieces, however, fails to form or create a single-piece body within the meaning of Appellants' claimed invention, i.e., a single-piece body formed from the same material.

Ward relates to "a frame and permanent magnet assembly for a dynamoelectric machine where the frame carries a plurality of permanent magnets. The frame is formed of iron powder particles that are bound together by a thermoplastic material" (see Abstract). However, there is no teaching or suggestion in *Ward* that the frame 12 and the magnets 14 can be made from a single-piece of a single material. See, e.g., col. 2, lines 8-10 of *Ward*, which states that frame 12 is molded to the magnets 14.

Appellants' claimed invention replaces prior art components that are formed from different materials, i.e., the stator ring and magnet shells, with a single-one piece component which is formed entirely from the same material. Moreover, the components of the claimed fuel feed unit that are formed into a single-piece body have different functions. That is, the claimed electric motor stator ring and the magnet shells each have different functions. Only the present application teaches that these components are manufactured from the same material. There is no teaching or suggestion in *Ward* of Appellants' claimed components that are arranged in a single-piece body made of the same material. That is, there is no teaching or suggestion in *Ward* of an electric motor stator ring and the magnets that comprise a single-piece of a single material.

The Examiner (at pg. 4) takes the position that "the casing [of the *Ward* assembly] is formed as a composite material made up of a blend of iron and plastic ... which allows the casing to simultaneously form both the stator and motor casing (i.e., portions that provide separate and distinct functionality)" based on the teachings of *Ward* at col. 5, lines 37-39. However, even assuming *arguendo* that the teachings of *Ward* at col. 5, lines 37-39 are applicable to *Tuckey* – which in any event Appellants dispute – *Ward* fails to teach or suggest applicants' claimed feature, i.e., "wherein the electric motor stator ring and the magnet shells comprise a single-piece body formed as a single piece of a single material", as recited in independent claim 1. Fig. 1 of *Ward* clearly shows that the permanent magnet 14, i.e., magnet shells, are separate and distinct from the composite material for the frame 12. Moreover, the skilled person has no reason to modify the *Ward* structure to include the recited limitation of independent claim 1 such that the frame 12 and the permanent magnets 14 would be included in a single piece of a single material, absent an impermissible hindsight construction based on Appellants' instant disclosure.

Accordingly, the combination of *Tuckey* and *Ward* thus fails to achieve independent claim 1, because *Ward* fails to provide what *Tuckey* lacks.

Dependent claims 2-11 are allowable for at least the same reasons as independent claim 1.

For the foregoing reasons, it is respectfully submitted that the combined teachings of *Tuckey* and *Ward* fail to establish a *prima facie* case of obviousness with regard to the subject matter recited in claims 1-11. The Final Rejection of claims 1-11 should be reversed.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that Appellants' claims are not rendered obvious by the combination of *Tuckey* and *Ward* and are, therefore, patentable over the art of record, and the Examiner's rejections should be reversed.

Respectfully submitted,
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CLAIMS APPENDIX

1. (Previously Presented) A fuel feed unit for delivering fuel, comprising:

an electric motor;

an electric motor stator ring;

magnet shells arranged inside the stator ring; and

a motor casing to accommodate the stator ring;

wherein the electric motor stator ring and the magnet shells comprise a single-piece body formed as a single piece of a single material.

2. (Previously Presented) The fuel feed unit as claimed in claim 1, wherein the single-piece body is produced from a plastic with ferrite particles embedded therein.

3. (Previously Presented) The fuel feed unit as claimed in claim 2, wherein the plastic is polyphenyl sulfide.

4. (Previously Presented) The fuel feed unit as claimed in claim 1, further comprising a casing part of a feed pump for delivering fuel in a fuel tank, said casing part forming a portion of the single-piece body.

5. (Previously Presented) The fuel feed unit as claimed in claim 1, wherein the single-piece body comprising the electric motor stator ring includes a flange for joining to a connection piece for permitting connection of the fuel feed unit to a fuel line.

6. (Previously Presented) The fuel feed unit as claimed in claim 1, wherein the single-piece body comprising the electric motor stator ring includes a bearing for a rotor.

7. (Previously Presented) The fuel feed unit as claimed in claim 1, wherein the single-piece body comprising the electric motor stator ring is joined in one piece to a component having a duct of the feed pump.

8. (Previously Presented) The fuel feed unit as claimed in claim 1, wherein the single-piece body comprises only the single piece of the single material and simultaneously forms the electric motor stator ring, the motor casing and the magnet shells.

9. (Previously Presented) The fuel feed unit as claimed in claim 8, wherein the single piece body is injection molded plastic with embedded ferrite particles.

10. (Previously Presented) The fuel feed unit as claimed in claim 7, wherein the duct of the feed pump is arranged in the motor casing.

11. (Previously Presented) The fuel feed unit as claimed in claim 1, wherein the electric motor includes a rotor, the magnet shells inducing a magnetic flux in the rotor.

EVIDENCE APPENDIX

N/A

RELATED PROCEEDINGS APPENDIX

N/A